

REMARKS

The Office Action and the cited and applied references have been carefully reviewed. Claims 2, 3, 20-24, 38-40, and 42-48 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 2, 4, 20 and 38 have been rejected under 35 U.S.C. §102(b) as being anticipated by Nagase insofar as the fragments of subpart(c) of claim 2 (and claims dependent therefrom) are concerned. This rejection is obviated by the cancellation of claim 2 subpart(c) and claim 4. The claims objected to as being dependent from a rejected base claim (claim 2) are now allowable as well.

Claims 21-24 and 44-46 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Nagase in view of applicant's admission in the paper filed September 23, 2002, that it would be obvious for one of skill in the art to make antibodies to a protein known in the art. The examiner states that with regard to applicant's admission, there is no specific definition as to what represents a "biological function" or "biological property" as it relates to motivation for making an antibody to a protein. The examiner then states that the terms "biological function" or "biological property" must be interpreted broadly and thus includes tissue-specific expression of a gene/protein. The examiner asserts that Nagase teaches a "biological function/property" for KIAA0849 in the broadest reasonable interpretation of the term "biological function/property", which is expression of KIAA0849 in the brain. It is the examiner's

position that given this "biological function/property", the ordinary skilled artisan would be motivated to generate antibodies against KIAA0849 in order to monitor the brain tissue-specific expression of the protein. This rejection is respectfully traversed.

Applicant concedes that it is obvious to make a monoclonal antibody to a protein when the protein's biological activity or function is known. However, the mere presence of expression of an open reading frame (i.e., KIAA0849, which is not even the complete protein) in the brain cannot be considered to be a "biological activity or function" as would be commonly understood or recognized in the art. Just because a protein exists in a human body or even in one tissue of the body does not mean the protein has a "known" biological activity or function that would motivate one of ordinary skill in the art to make antibodies thereto. No one would be motivated to monitor the expression of a protein of unknown activity or function.

Certainly, Nagase does not disclose any "biological activity or function" as commonly understood by this term to those of ordinary skill in the art. Nagase even admits this by stating at the bottom of the left column on page 362, with regard to the expression profiles of predicted genes (including KIAA0849) shown in Fig. 3A, that:

However, from a neuroscientific viewpoint, the expression profiles among 10 tissues are not always satisfactory for extracting clues to identify their biological significance. (emphasis added)

Clearly, biological significance is not known if at most only "clues" are obtained by the expression profiles. Tissue-specific expression therefore does not confer biological activity, function or significance

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to a predicted gene/protein. Furthermore, Fig. 3A of Nagase does not even appear to show that expression of KIAA0849 is specific only to the brain tissue. Accordingly, without a specific biological activity, function or significance, there is simply no motivation for one of ordinary skill in the art to make an antibody against the putative protein encoded by the open reading frame from a predicted gene.

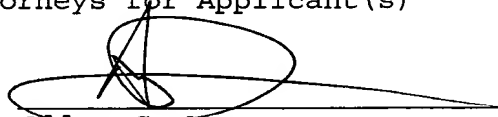
Reconsideration and withdrawal of the rejection are therefore respectfully requested.

In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting their allowance. Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,

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